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CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

October Term, 1941

No. 705

RADTKE PATENTS CORPORATION and
ALBERT A. RADTKE,

Petitioners,

against

CONWAY P. COE, Commissioner of Patents,
AMERICAN TRI-ERGON CORPORATION,
TRI-ERGON HOLDING A. G.,
WHITSON PHOTOPHONE CORPORATION and
DELMAN A. WHITSON,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA AND BRIEF IN SUPPORT THEREOF

LEONARD DAY,
Counsel for Petitioners.

October 6, 1941.

INDEX

PAGE

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA 1

A. Summary and Short Statement of the Matter Involved 2

Questions Presented 4

The Majority Opinion of the Court of Appeals Below 5

The Minority Opinion of the Court Below 7

B. Reasons Relied Upon for the Allowance of the Writ 7

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI 9

The Opinions of the Courts Below 9

Jurisdiction 10

Statement of the Case 10

Specification of Errors 10

Argument 11

POINT I—Petitioners were not afforded opportunity to be heard in respect of the scientific references not in the record 11

POINT II—The decisions of the Patent Office tribunals awarding priority to Radtke should have been affirmed 13

POINT III—The questions presented here are novel and of public importance 14

Conclusion 15

AUTHORITIES

PAGE

Altoona Publix Theatres Inc. v. American Tri-Ergon, 294 U. S. 477 15
American Tri-Ergon Corp. v. Robertson, 11 U. S. Pat. Q. 168 3

Helis v. Ward, 308 U. S. 365, 370, 84 Law Ed. 327, 329 12
Hill v. Wooster, 132 U. S. 693, 698 5

Morgan v. Daniels, 153 U. S. 120 13

Sundh Elec. Co. v. General Elec. Co. (2nd Circuit), 204 Fed. 277, 279 12
Swayne & Hoyt v. U. S., 100 U. S. 297, 304 14

U. S. v. Abilene & So. Ry. Co., 265 U. S. 274, 288 12

Walker on Patents (Deller's Edition), Vol. 3, p. 2025 12

Sec. 240 (a), Judicial Code (28 U. S. C. A. 347) 10

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To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioners, Radtke Patents Corporation and Albert A. Radtke respectfully pray for a writ of certiorari

to the United States Court of Appeals for the District of Columbia to review a judgment of that Court entered on June 30, 1941 (III R. 2081), rehearing denied August 29, 1941 (III R. 2094). A transcript of the record in the case, including the proceedings in said Court, we are informed has been furnished in accordance with the Rules of this Court.

A. Summary and Short Statement of the Matter Involved

The present suit is in equity, brought by American Tri-Ergon Corporation and Tri-Ergon Holding A. G. under United States Revised Statutes, Section 4915 (35 U. S. C. A. Section 63). Joined as defendants were Albert A. Radtke, Radtke Patents Corporation, Delmar A. Whitson, Whitson Photophone Corporation and Conway P. Coe, the Commissioner of Patents. The parties and their several interests are hereinafter set forth. Delmar A. Whitson and Whitson Photophone Corporation in their answer interposed a counterclaim seeking similar relief under Section 4915. The history of the litigation in short is as follows:

On March 3, 1919 Hans Vogt, Josef Engl and Joseph Massolle filed in Germany a German application for Letters Patent. On April 4, 1921 Vogt, Engl and Massolle filed an application for Letters Patent of the United States. The American Tri-Ergon Corporation and Tri-Ergon Holding A. G. are the assignees of Vogt et al. For convenience the application and the parties in interest will be referred to hereafter as "Vogt".

The four claims in controversy were made in the Vogt application in 1925. The Examiner found that the claims were unpatentable (II R. 1611) and the Board of Appeals affirmed (II R. 1619). Vogt thereafter filed a Section 4915 suit. After trial before Judge Adkins, a decree was

entered dated December 17, 1931 (II R. 1625—*American Tri-Ergon Corp* v. *Robertson,* 11 U. S. Pat. Q. 168) in which it was adjudged that these claims defined a patentable invention and authorized the Commissioner of Patents to issue Letters Patent thereon to Vogt.

By amendment, Whitson sought in his application for patent claims identical with the four claims in the Vogt application, which he copied in 1929 from the Vogt application. Whitson Photophone Corporation is the assignee of Delmar Whitson and both for convenience will be referred to hereafter as "Whitson".

Radtke from the time of filing his application in 1922 sought in his application claims similar in scope and then amended to include the same four claims held patentable by the Court. Radtke Patents Corporation is the assignee of Albert A. Radtke and both for convenience will be referred to hereafter as "Radtke".

In January, 1932 and after Judge ADKINS' decision the Commissioner of Patents instituted an interference proceeding between Vogt, Radtke and Whitson. Proofs were taken by all three parties. On July 18, 1936 the Examiner of Interferences awarded priority of invention to Radtke (III R. 1963). On March 17, 1937 the Board of Appeals affirmed the award of the Examiner (II R. 28). On January 22, 1938 the Board of Appeals, by its decision following a rehearing, reaffirmed its decision of March 17, 1937 (II R. 38). On April 19, 1938 a patent was issued to Radtke (U. S. Letters Patent 2,114,939).

The present suit was filed on May 13, 1938 by Vogt. On November 20, 1939 the District Court filed its decree (*American Tri-Ergon Corp.* v. *Coe,* D. C., 30 F. Supp. 83) awarding priority to Vogt and authorizing and ordering the Commissioner of Patents to issue Letters Patent embodying the four claims to American Tri-Ergon Corporation. An appeal was thereafter taken by Radtke and

Whitson to the United States Court of Appeals for the District of Columbia. On June 30, 1941 said Court of Appeals rendered its opinion holding all four counts unpatentable on publications not anticipating Radtke's proven date of invention, reversing the decree of the District Court and remanding the same with instructions to dismiss the complaint, Judge STEPHENS dissenting (III R. 2056). Petition for rehearing by Whitson was denied on August 29, 1941.

The party Vogt has already filed its petition herein for a writ of certiorari to the said United States Court of Appeals for the District of Columbia. Radtke makes this petition for similar relief.

Questions Presented

The substantial questions presented here are:

1. Whether the Court of Appeals should not have passed upon the questions of the incorrectness of the decree of the District Court below and the correctness of the rulings of the Patent Office tribunals on the issue of priority and the ancillary issues of disclosure and reduction to practice, rather than on the question of patentability.

2. Whether the Court below properly could consider and rely upon as established fact highly debatable scientific references on the question of patentability, which were neither in the record nor referred to in the briefs and which none of the parties had opportunity either to discuss or to meet with expert testimony and which the evidence shows are not prior to the date of invention by the party Radtke.

The Majority Opinion of the Court of Appeals Below

The United States Court of Appeals for the District of Columbia, upon suggestion of *amicus curiae* first presented on appeal, undertook to decide whether the four claims in issue did define an invention patentable as of March 3, 1919 (a date long after Radtke's 1916 date).

Accordingly, it inquired into the correctness of the rulings of Mr. Justice ADKINS in the original 4915 suit brought by American Tri-Ergon against Robertson, then Commissioner, wherein Mr. Justice ADKINS had held that the four claims did define patentable invention.

The Court undertook to examine this question in its capacity as "guardian of the public interest", relying upon the case of *Hill* v. *Wooster*, 132 U. S. 693, 698. As is pointed out in the dissenting opinion of the Court below, it is submitted that the case at bar is distinguishable.

The Court ignored the question of the incorrectness of the decree of the District Court below and the correctness of the rulings of the Patent Office tribunals on the issue of priority and the ancillary issues of disclosure and reduction to practice. It merely contented itself with the statement, "We may assume hypothetically, that either the Patent Office or the District Court correctly decided the question of priority, as between such disclosures as may have been made by each of the parties" (III R. 2077-2078). Upon the pleadings the only issues before the trial Court were that of priority of invention and the further ancillary issue as to whether Vogt's application disclosed what was defined in the claims in suit. The parties directed themselves mainly to the question of priority of invention and the ancillary questions thereto.

The majority of the Court of Appeals relied upon highly debatable scientific references on this question of

patentability which were neither in the record nor referred to in the briefs. We submit that Mr. Justice STEPHENS was correct when he stated in his dissenting opinion that the Court cannot take judicial notice of disputed facts. Your petitioners further agree with Judge STEPHENS' statement that "an appeal court cannot properly reach an answer to such a question upon the basis of its own examination of data not in the record, and which may be disputable, without first affording opportunity to the parties to be heard in respect of it and an opportunity to supply additional relevant data." It is to be noted that the majority of the Court of Appeals relied upon publications some of which were published as late as the 1930's and relied upon statements made therein as anticipatory. In the proofs Radtke sought the date of late 1916 for his date of conception. The Patent Office Examiner, on the evidence, granted priority of invention to Radtke, holding that Radtke had conceived in March, 1917 and reduced to practice in September, 1919. The Board of Appeals held it unnecessary exactly to determine Radtke's conception date prior to 1919 and gave him the dates September and November of 1919 for his reduction to practice. The Court below, in relying upon these publications of the 1930's, took the highly debatable statements therein contained of what were or were not facts as of the dates which each of the parties sought to obtain and which Radtke did obtain. Your petitioners submit that these publications speak as of the 1930's. It is easy with afterthought to attribute lack of invention to the pioneer who has taught us. Perhaps the majority of the Court did not realize that they were speaking of the 1930's and not of the date which Radtke claimed.

The invention, upon which Radtke has been granted a patent, is admittedly a highly important one, has gone

into wide commercial use and is in common use in sound picture apparatus. Many licenses have been taken by the industry under the Radtke patent. The question of patentability in such a case is debatable and should not have been, in all fairness to Radtke, decided for the first time on appeal without first affording the parties an opportunity to adduce testimony thereon.

The decision of the Court of Appeals, if correct, would ignore the rights of parties to be confronted with and have the opportunity to meet all questions raised on appeal for the first time. It would deprive a party of the right to be heard. It would permit a Court to rely upon statements made in questionable texts covering highly scientific problems as fact rather than as disputable and debatable matter. It would further ignore the interests and rights of an inventor and the public to have judicially determined the questions of *originality* and *priority*.

The Minority Opinion of the Court Below

The minority opinion of Mr. Justice STEPHENS is so well and tersely stated that no further statements need be made.

B. Reasons Relied Upon for the Allowance of the Writ

The discretionary power of this Court is invoked upon the following grounds:

1. The United States Court of Appeals for the District of Columbia has decided novel and important questions of Federal law in a manner which is believed to be untenable and in direct conflict with the applicable decisions of this Court.

2. The United States Court of Appeals for the District of Columbia has decided important questions of Federal law the effect of which is of great public importance and interest.

WHEREFORE your petitioners respectfully pray the allowance of a writ of certiorari to the United States Court of Appeals for the District of Columbia and submit their brief in support of this petition.

Respectfully submitted

LEONARD DAY,
Counsel for Petitioners.

Dated, October 6, 1941.